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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,448	11/06/2003	Hiroshi Komatsu	X00	7624
20457	7590	11/23/2004	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP			LE, HOA VAN	
1300 NORTH SEVENTEENTH STREET			ART UNIT	
SUITE 1800			PAPER NUMBER	
ARLINGTON, VA 22209-9889			1752	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/701,448	KOMATSU, HIROSHI	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 with respect to the applied species is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06 November 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

This is in response to Paper filed on 12 October 2004.

- I. Correction: In paragraph E, line 5 of the Office action mailed 10 September 2004, "restriction" is corrected to be ---species election requirement---.
 - II. The elected species chemical structure has been considered and searched. The consideration and search are extended to the applied species. Others have not been considered or searched until the applied species is overcome.
 - III. Applicant's prior art submission filed on 06 November 2003 has been considered to the extent of US '521 and its equivalent JP '862. An English language translation of claim 2 in JP '828 and English Abstracts of JP '620 and JP '070 are not in the Office electronic file application. They may have been lost in a process. Please resubmit to fulfill the record.
 - IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
- Claims 1-13 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneda et al (JP 2002012665 with respect to machine English language

translation of "CLAIM", 3 pages and "DETAILED DESCRIPTION", 24 pages and "ANSWERS 9 OF 13" in the computer generating chemical structure searches from pages 79-83).

Kaneda et al disclose, teach and suggest a resin composition for use as an interlayer insulating film and surface protective coat in a semiconductor device and electronic part having semiconductor device. The composition comprises a photosensitive compound, a solvent and a compound being read within the general formula (1) as claimed. Please see the whole disclosure of the applied reference, especially in ANSWERS 9 OF 13 with chemical structure on pages 81-83, in CLAIMS with claims 3, 5 and 6 and in DETAILED DESCRIPTION at paragraphs 0033-0035, 0044, 0059, 0072-0074, 0117-0119 and 0128-0131. Since Kaneda et al disclose, teach and suggest the claimed embodiments, the above claims are found to be rendered prima facie obvious by Kaneda et al.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
22 November 2004

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le